

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

Mailed: December 15, 2005  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Viking Life-saving Equipment A/S

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Serial No. 76269527

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Donald N. Huff of Dykema Gossett PLLC for Viking Lifesaving Equipment A/S.

Gina M. Fink, Trademark Examining Attorney, Law Office 103  
(Michael Hamilton, Managing Attorney).

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Before Hairston, Bucher and Zervas, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Viking Life-Saving Equipment A/S has filed an  
application to register the mark VIKING in standard  
character form for goods and services which were ultimately  
identified as:

life-saving rafts, hydrostatic release for life-  
saving rafts, life-saving boats, protection cover  
for life-saving boats, life jackets, life-saving  
equipment, namely, floating lines, excluding  
diving suits; emergency warning lights, fire  
fighting suits, boxes specifically designed for  
carrying fire fighting and life-saving equipment,  
boxes specifically designed for carrying

emergency breathing apparatus; emergency and rescue flares, life buoys, life buoy brackets, life buoy lights, radar reflectors and emergency signal whistles in International Class 9;

installation and maintenance of all kinds of safety and life-saving equipment in International Class 37; and

training and educational services, namely conducting classes and seminars in the use of all kinds of safety and life-safety equipment in International Class 42.<sup>1</sup>

The trademark examining attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the three marks shown below, all previously registered to the same owner, Viking Fotttoy A/S, that, if used on or in connection with applicant's "fire fighting suits," in particular, it would be likely to cause confusion.

(1)



for, inter alia, "protective clothing, namely suits for protection against chemicals and gases" in International

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<sup>1</sup> Serial No. 76269527, filed June 8, 2001, based on an allegation of a bona fide intention to use the mark in commerce.

Ser No. 76269527

Class 9. Registration No. 1,529,361 issued March 14, 1989;  
Section 8 affidavit filed. The drawing is lined for the  
colors red and blue.

(2)



for "protective shoes and boots" in International Class 9.  
Registration No. 1,603,452 issued June 26, 1990; renewed.  
The drawing is lined for the colors red and blue.

(3)



for, inter alia, "fire fighting boots for protection  
against accidents, irradiation and fires" in International  
Class 9. Registration No. 2,376,528 issued August 15,  
2000. The registration contains the following statement:  
The mark consists of the word "Viking" with a  
representation of the letter "V" claiming the color red  
within a blue rectangle.

Applicant has appealed. Both applicant and the  
examining attorney have filed briefs, but an oral hearing

was not requested. We affirm the refusal to register the goods in Class 9.<sup>2</sup>

At the outset, we note applicant's statement in its brief on the case that it was negotiating a consent agreement with the owner of the cited registrations. While the Board generally will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed prior to the rendering of the Board's final decision, no such agreement has been submitted in this case. See TBMP §1207.02 (2<sup>nd</sup> ed. rev. 2004). Thus, the Board will not suspend this proceeding.

We turn then to the issue of likelihood of confusion. Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the

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<sup>2</sup> In her appeal brief, the examining attorney's arguments with respect to likelihood of confusion focus on the relationship between applicant's fire fighting suits in Class 9 and the goods in the three cited registrations. There is no specific discussion of the relationship between applicant's services in Classes 37 and 42 and the goods in the cited registrations. Thus, we consider the refusal to register with respect Classes 37 and 42 to be withdrawn.

marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also: *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Considering first the marks, the examining attorney contends that applicant's mark and each of the cited marks are similar because the dominant portion of each of the marks, VIKING, is identical.

Applicant, on the other hand, argues that each of the cited marks is set forth in the colors red and blue which serves to distinguish each of the cited marks from applicant's mark.

Our consideration of the marks is based on whether applicant's mark and each of the cited marks, when viewed in their entirety, are similar in terms of appearance, sound, connotation and commercial impression. However, it is nevertheless the case that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark provided [that] the ultimate conclusion rests on consideration of the marks in their entirety." *In re National Data Corp.*, 753 F.2d 1056, 224

USPQ 749, 751 (Fed. Cir. 1985). In the case of marks which consist of words and a design, the words are normally accorded greater weight because they would be used by purchasers to request the goods. See *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987).

With respect to the cited marks, it is the term VIKING that is the dominant feature of each of these marks. The word VIKING dominates over the design features and it is the word VIKING that customers will remember and use in calling for the registrant's goods.

Insofar as applicant's VIKING mark is concerned, it is sought to be registered in standard character form. Thus, we must consider all reasonable manners in which applicant's mark could be depicted. See *Jockey International Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992). This would include the same style lettering as used by registrant in the cited marks and, applicant would be free to depict its mark in any colors, including red and blue.

In sum, we find that when the marks are considered in their entireties, they are substantially similar in sound, appearance, connotation and commercial impression.

Considering next the goods, the examining attorney contends that applicant's fire fighting suits are the same

as or closely related to registrant's protective clothing, namely suits for protection against chemicals and gases (Registration No. 1,529,361). Further, it is the examining attorney's position that applicant's fire fighting suits and registrant's protective shoes and boots (Registration No. 1,603,452) and fire fighting boots (Registration No. 2,376,528), are complementary goods.

Applicant, on the other hand, argues that its fire fighting suits are for use in the maritime industry and are sold in different channels of trade than registrant's goods; and that the purchasers of its fire fighting suits are sophisticated.

As has often been stated, it is not necessary that the goods and/or services of the parties be similar or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re*

International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). Moreover, the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the cited registrations. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

In this case, we find that applicant's fire fighting suits are at the very least closely related to registrant's protective clothing, namely suits for protection against chemicals and gases. In the absence of any limitations in registrant's identification of goods, we must consider that registrant's protective clothing, namely suits for protection against chemicals and gases, are of a type that may be worn by fire fighters, especially fire fighters fighting chemical or gas fires. Similarly, we must consider that registrant's protective shoes and boots also are of a type that may be worn by fire fighters. Thus, applicant's fire fighting suits and registrant's protective shoes and boots are clearly complementary goods. Further, applicant's fire fighting suits and registrant's fire fighting boots for protection against accidents, irradiation and fires are complementary goods.



Further, we find that applicant's and registrant's goods are of types which normally are sold in and to the same or overlapping trade channels and purchasers, i.e., municipal and private fire departments. Applicant argues that its goods and registrant's goods, as actually marketed, are used in different industries. In particular, applicant argues that its goods are used in the maritime industry, whereas registrant's goods are used in other industries for protection against fire and environmental hazards. However, no such limitations or restrictions appear in applicant's or registrant's identification of goods, and they therefore can be given no consideration. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) and *Canadian Imperial Bank*, *supra*.

Applicant also has asserted that the consumers for its goods are sophisticated. We agree that clothing and shoes and boots worn by fire fighters are not impulse purchases. However, because of the similarities of the marks and the goods, even careful and sophisticated purchasers are likely to believe that these marks are variants of each other, and that the marks identify goods emanating from a single source.

Finally, applicant asserts that it and the registrant have used their marks concurrently for six years without any evidence of actual confusion, and that this shows that confusion is not likely to occur. We are not persuaded by this argument. Applicant has not provided any evidence as to the extent of its use, nor is there any evidence as to registrant's use, such that we can determine whether there has been an opportunity for confusion to occur. In any event, the issue before us is not one of actual confusion, but only the likelihood of confusion.

In view of the foregoing, we conclude that purchasers and prospective customers familiar with each of registrant's VIKING and design and V VIKING and design marks for protective clothing, namely, suits for protection against chemicals and gases, protective shoes and boots, and fire fighting boots, would be likely to believe, upon encountering applicant's substantially similar mark VIKING for fire fighting suits, that the respective products emanate from or are associated with or sponsored by the same source.

**Decision:** The refusal to register applicant's mark for its goods in Class 9 is affirmed. The application will proceed as to the services in Classes 37 and 42.